

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.:	10/687,036	Confirmation No.:	7495
Appellant(s):	Jalkanen et al.		
Filed:	October 16, 2003		
Art Unit:	2876		
Examiner:	Trail, Allyson Neel		
Title:	TERMINAL, METHOD AND COMPUTER PROGRAM PRODUCT FOR INTERACTING WITH A SIGNALING TAG		

Docket No.: 042933/269519
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P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 CFR § 41.41

This Reply Brief is filed pursuant to 37 CFR § 41.41 and is filed in response to the Examiner's Answer of April 15, 2008, the Examiner's Answer being in response to an Appeal Brief filed November 13, 2007. This Brief addresses a number of points arising from the Appeal Brief, as well as the Examiner's Answer to the same.

10. *Response to Argument.*

The Examiner's Answer responded to Appellant's arguments under subsections A and B of section 7 of the Appeal Brief. Accordingly, Appellant addresses the Examiner's position under those same subsections below. Again, currently, pending Claims 1, 2, 11, 12, 14-16, 29 and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0022961 to Sepanaho; and Claims 4, 18, 25, 26, 32, 39 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sepanaho in view of either U.S. Patent Application Publication No. 2002/0191998 to Cremon et al., or U.S. Patent Application Publication No. 2004/0203413 to Harumoto.

A. Claims 1, 2, 11, 12, 14-16, 29 and 30 are Patentable over Sepanaho

As explained in Appellants' Appeal Brief, in contrast to the invention of independent Claim 1, Sepanaho does not teach or suggest determining whether the terminal is actively operating an application, or performing a predefined action based upon the application and the state of the application if the terminal is actively operating an application. Sepanaho does disclose a user device receiving a URL from a short-range URL broadcast device and then requesting information from the entity identified by the URL. Instead of determining whether the user device is actively operating an application as in the claimed invention, however, Sepanaho discloses executing a software program for receiving the URL, and for launching a browser to request information from the received URL. The Sepanaho system is configured to perform a series of steps irrespective of a determination of whether the software program or browser is actively operating on the terminal.

The Examiner takes the position that Sepanaho determines whether the device is actively operating an application by determining whether the device includes an appropriate software program (e.g., Internet browser) for processing the URL received from the short-range radio URL broadcast device. The Examiner's Answer explains that paragraph 0002 of Sepanaho discloses that transmission of a URL causes a software program to be executed; and that, in turn, the software program launches an appropriate program (e.g., browser) and passes the URL to the program to load the information at the respective URL. As suggested by the Examiner, this sequence of steps includes the device determining whether it is actively operating the application to be launched before performing a predefined action (transmitting the URL). Appellants continue to disagree.

Appellants first note that Claims 1, 2, 11, 12, 14-16, 29 and 30 stand rejected as being anticipated by Sepanaho, and that anticipation of a claim requires a single cited reference to explicitly or inherently disclose each and every element of the claimed invention. MPEP § 2131. Appellants respectfully submit that nowhere has the Examiner cited any passage of Sepanaho that explicitly discloses the aforementioned determining or performing functions of independent Claim 1. Rather, the Examiner cites to various passages of Sepanaho and provides an accompanying explanation to presumably establish that Sepanaho inherently discloses the recited

functions. As explained in the MPEP, however, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or in technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP § 2112, *quoting Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). And in the instant case, the Examiner has failed to provide any facts or technical reasoning to support the conclusion that Sepanaho inherently (necessarily, if not explicitly) discloses the aforementioned determining or performing functions of independent Claim 1.

Relative to the recited feature of determining whether the terminal is actively operating an application, the Examiner states as follows:

... The software contained on the user device used to launch [the] Internet browser is considered to be the actively operating application. It must be determined that the user device includes this actively operating software application in order to ensure that the URL can be launched in the user device. The launching of the URL is considered to be the predefined action based upon the application and state of the application.

Examiner’s Answer, page 7. Initially, Applicants note that the Examiner appears to be confusing a determination as to whether a terminal is performing a particular function (actively operating an application), with a determination as to whether a terminal includes the object of that function (application). The Examiner continues to refer to “the actively operating application,” even though the claims recite “actively operating an application.”

Again, Sepanaho presumes that its user device includes the software necessary to carry out its disclosed system and method; and accordingly, Sepanaho does not require its user device, URL broadcast device or any other entity to determine if that software is present. *See Sepanaho*, page 2, paragraphs 0018 and 0019 (explaining that “the invention includes ... software which is contained within the user device”; and “the software contained within the user device may ... launch other software programs, on the user device...”). Taking the interpretation that the software program used to launch the browser corresponds to the actively operating application, as alleged by the Examiner, Sepanaho must disclose determining whether the terminal is actively operating that software application to even arguably anticipate independent Claim 1. But Sepanaho explicitly discloses the linear functionality of launching that software program in

response to transmission of a URL, without any determination of whether the software program is actively operating at any particular time. And since it is equally plausible that the software program is configured to automatically shut down after launching the browser and passing the URL to the browser, it cannot be said that Sepanaho inherently (necessarily, if not explicitly) determines whether the software application is actively operating to determine whether it needs to be launched in response to transmission of a URL or may just otherwise operate on the URL as disclosed.

Appellants note that the Examiner's Answer attempts to demonstrate that Sepanaho contemplates user devices that do not have the necessary software to launch a browser and pass a received URL to that browser, or that do not have a browser or Internet access, and that accordingly, a determination must be made as to the existence of that software on a user device. This line of reasoning, however, is also based on the false premise that determining the mere existence of software on the user device corresponds to determining whether the user device is actively operating that software, as per independent Claim 1. As explained in Appellants' Appeal Brief, as readily understood by those skilled in the art, for a device to actively operate an application, that device must not only include the application but must also execute one or more instructions with respect to that application. A device need not execute one or more instructions with respect to an application merely because the device includes that application. Accordingly, a device may include an application without actively operating that application.

As support for the Examiner's position relative to user devices not enabled to carry out the functions of Sepanaho's described invention, the Examiner cites paragraph [0017] of Sepanaho, and the following passage in particular: "The systems, methods, programs, and processes described in relation to the present invention are not limited to any particular user device." This passage, however, does not support the explicit or inherent (necessary, if not explicit) disclosure in Sepanaho of a user device not including the requisite software to carry out the functions of Sepanaho's described invention, or accordingly, determination as to whether the user device includes that software. Rather, the aforementioned passage merely stands for the proposition that a number of different user devices may be used to carry out the described invention. But since the described invention requires the appropriate software, what ever the

user device used to carry out the invention, Sepanaho is premised on that user device including the requisite software. *See* Sepanaho, page 2, paragraphs 0018 and 0019 (explaining that “the invention includes ... software which is contained within the user device”; and “the software contained within the user device may ... launch other software programs, on the user device...”).

Appellants do note that Sepanaho does refer to “compatible” user device and URL broadcast device. Sepanaho, paragraphs [0025]-[0026]. This reference, however, also does not support the explicit or inherent (necessary, if not explicit) disclosure in Sepanaho of a user device not including the requisite software to carry out the functions of Sepanaho’s described invention, or accordingly, determination as to whether the user device includes that software. In the context of the paragraphs in which Sepanaho refers to “compatible” devices, Sepanaho discloses its devices scanning for and connecting to one another in accordance with a transmission protocol such as IEEE 802.11b or Bluetooth. Thus, rather than referring to devices that include the requisite software as being “compatible,” Sepanaho is clearly referring to devices that are enabled to communicate in accordance with the same (or compatible) transmission protocol.

In view of the foregoing as well as the remarks presented in Appellants’ Appeal Brief, Appellants respectfully submit that the invention of independent Claim 1, and by dependency Claims 2-14, is patentably distinct from the system and method of Sepanaho. Appellants also respectfully submit that the independent Claims 15 and 29 recite subject matter similar to that of independent Claim 1. In this regard, both independent Claims 15 and 29 recite determining whether the terminal is actively operating an application, and if the terminal is actively operating an application, performing a predefined action based upon the application and the state of the application. Thus, Appellants respectfully submit that independent Claims 15 and 29, and by dependency Claims 16-28 and 30-41, are also patentably distinct from Sepanaho for at least the same reasons given above and in Appellants’ Appeal Brief with respect to independent Claim 1.

B. Claims 4, 18 and 32 are Patentable over Sepanaho in view of Cremon

As indicated above, dependent Claims 4, 18 and 32 stand rejected as being unpatentable over Sepanaho in view of Cremon. And as explained in Appellant’s Appeal Brief, similar to

Sepanaho, Appellants respectfully submit that Cremon does not teach or suggest determining whether the terminal is actively operating an application, or performing a predefined action based upon the application and the state of the application if the terminal is actively operating an application, as recited by independent Claims 1, 15 and 29, and by dependency Claims 4, 18 and 32. As further explained, even if Sepanaho and Cremon did disclose respective features of the claimed invention, one skilled in the art would not have been motivated to modify the Sepanaho system to include the alleged feature of the Cremon system “to perhaps ask the signaling device for additional information or communicate that the data transmitted from the tag to the user device was faulty and to resend the data,” as alleged by the Examiner.

Dependent Claims 4, 18 and 32, include among other recitations, writing data to the signaling tag. As currently applied against Claims 4, 18 and 32, Cremon discloses “[s]oftware programmable products, for example, cellular telephones and wireless enabled data or computer devices have receiver/transmitter circuitry that could be adapted to read and/or encode RFID’s. The present invention may use this circuitry to read and or write to the reconfiguration data on an RF tag, or receive RF data directly into the product’s circuitry via an onboard RFID circuit.” Cremon, paragraph [0020]. Initially, Appellants note that it is common understanding in the art that writing data connotes recordation of data on a storage medium. *See, e.g.,* Newton’s Telecom Dictionary 946 (2005) (write: “To record information on a storage device, usually disk or tape.”). Thus, by its very terms, writing data to a signaling tag per dependent Claims 4, 18 and 32 is not the same as merely bi-directionally communicating with that tag. And as such, it does not make sense that one skilled in the art would be motivated to record data on Sepanaho’s URL broadcast device (write data) for the purpose of merely enabling bi-directional communication with that device to ask the device for additional information or communicate a retransmission request to the device, as alleged by the Examiner. And even if one skilled in the art would be motivated to modify Sepanaho to include the alleged bi-directional communication with its URL broadcast device, it does not follow that one skilled in the art would be motivated to write data to that device, similar to the signaling tag of Claims 4, 18 and 32.

Moreover, as explained in Appellants’ Appeal Brief, the Sepanaho system is already configured to receive a URL from the radio transmitter. Thus, why would Sepanaho require

communication back to the transmitter for receiving additional information as opposed to just sending such additional information along with the URL. Also, as the user device receives the URL for the explicit purpose of receiving information from the URL, Appellants question what benefit the Sepanaho system would receive from providing additional information via the radio transmitter, as opposed to providing such information via the URL. Moreover, as to notifying the tag of faulty data, why would the user device just not reestablish a link with the radio transmitter to again receive the URL from the radio transmitter, instead of communicating to the radio transmitter that the received URL was faulty to trigger the radio transmitter to again transmit the URL. It would appear that reestablishing a link with the radio transmitter could be accomplished by the Sepanaho system alone, while requiring additional communication with the radio transmitter would, as suggested by the Official Action, require adding further logic to the components of the Sepanaho system.

In the Examiner's Answer, the Examiner explains that, "it is suggested by Sepanaho in paragraph 0030 that a user/customer can selectively or automatically receive information about products and services offered in proximity of the transmitter. If the user device is in the selective mode, the user would have to request data from the signaling tag in order to obtain further information." Examiner's Answer, pages 10-11. This reasoning, however, is faulty in that it suggests Sepanaho's system is a pull-type system in which the user device actively requests data from its URL broadcast device. Nowhere, however, does Sepanaho disclose its system is a pull-type system. Rather, Sepanaho discloses that its URL broadcast device transmits a URL to a user device after scanning and connecting to that device, clearly suggesting a push-type system in which the URL is sent to the user device absent any explicit request from the user device. The user of the respective device may be able to selectively accept the URL received by the user device before information associated with that URL is retrieved by the browser (thereby enabling selective receipt of information – see paragraph 0030). But even in this instance, the selectivity is in the user device communicating with the server to retrieve the appropriate information, not in the user device communicating with the URL broadcast device. Thus, Appellants maintain that it is not obvious that one skilled in the art would be motivated to modify Sepanaho as alleged by

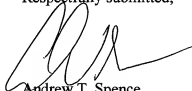
the Examiner (although again noting that the alleged motivation for the modification does not support the alleged modification).

In view of the foregoing as well as the remarks presented in Appellants' Appeal Brief, Appellants respectfully submit that the claimed invention of dependent Claims 4, 18 and 32 is patentably distinct from Sepanaho and Cremon, taken individually or in combination.

CONCLUSION

For at least the foregoing reasons, as well as those presented in Appellants' Appeal Brief, Appellants respectfully request that the rejections be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Andrew T. Spence', with a long horizontal flourish extending to the right.

Andrew T. Spence
Registration No. 45,699

CUSTOMER No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111
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